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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FISCHETTI, JOSEPH A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/441,107

Applicant(s)

HOFFMAN, NED

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 16, 19, 22, 24, 25 and 28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8, 16, 19, 22, 24, 25 and 28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

Claims 1,3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6269348, 5870723 and 5838812. Although the conflicting claims are not identical, they are not patentably distinct from each other because at least claim 1 of the identified patents can be read on claims 1 and 3 of this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 16, 19, 22, 24, 25, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 3 refer to the method as "tokenless". However, these claims proceed to recite: a proposal step, a registration step, etc. Such steps would clearly require the transmission of a structured data object or textual element. Attached is a copy of the definition of token from the *Computer Dictionary 2nd Edition* in which the definition of token is described and is deemed to read on claims 1 and 3. Therefore the claim of tokenless cannot be maintained. Otherwise if there is something in this invention which makes such a feature possible which is not being recited in the claims, then this must be recited for the benefit of as full examination. The examiner seeks to

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have this language removed in light of the above noted definition which was later developed following the first Office on the merits.

The language in claims 1 and 3 "without the scrip supporter presenting any smartcards or magnetic swipe cards" is a negative limitation.

Claims 5,6, 19 22, 24, 25, 28 are improperly presented Markush recitations and hence have plural meanings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2, 3, 4,7, 8, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Merjanian.

Merjanian disclose with respect to the Authentication system for use with a computer terminal col. 9 or the example of the welfare recipient of col.11 lines 1-21, which do not involve a smart cart and thus, is "tokenless", and transmits though an interface 40 and thus meets the limitations of: a. a scrip supporter registration step, wherein a scrip supporter registers with an electronic identicator at least one registration biometric sample (see col. 9 lines 31-33, fingerprint data must match predetermined parameters which parameters inherently require the step of registration) ; b. an electronic scrip

transaction proposal step comprising an electronic scrip donator account data(account is read as the user account of the computer) at least one transmittal step, wherein a scrip supporter bid biometric sample is obtained from the scrip supporter's person and is electronically transmitted to the electronic identicator (col. 9 lines 41,42 finger print data is conveyed via interface 40 to data base 24) ; and d. a scrip supporter identification step, wherein the electronic identicator compares the bid biometric sample with at least one registration biometric sample for producing either a successful or failed identification of the scrip supporter Col. 9, line 33 a match is sought against the two data for the finger prints) wherein upon successful identification of the scrip supporter, a scrip transaction is biometrically authorized, (access to the terminal is thus allowed). The phrase "without the scrip supporter presenting any smartcards or magnetic swipe cards" is met by the example of computer login or the example of the welfare recipient of col.11 lines 1-21, but notwithstanding this, the language remains a negative limitation and is not given weight.

Re claim 2: the database is also disclosed as part of the local scanner.

Re claim 3, 4, 8: the Medicaid office is read as a clearing house for medical claims/payments. The disclosed matching program using minutiae of the fingerprint characteristics is read as the rule module.

Re claim 7: interface 40 transmits to an external system.

Re claim 16: the Medicaid account is read as the donor account.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.

